

REMARKS

In the Final Official Action, the Examiner rejected claims 1-20. In this Amendment and Response, the Applicants amended claims 1, 5-7, and 13 to *clarify* the unique aspects of the present claims to expedite allowance of the pending claims 1-20. Applicants emphasize that these amendments simply *clarify the orientation* of certain features based on the Examiner's Response to Arguments in the Final Office Action. *See Paper 10, page 5.* Accordingly, these amendments do not add any new matter, and place the claims in condition for allowance without requiring a new search or examination. In view of the foregoing amendment and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1, 2, and 6 under U.S.C. § 102 as anticipated by Klein et al. (U.S. Patent No. 6,186,800). Applicants respectfully traverse these rejections.

Klein et al. Do Not Anticipate Claims 1, 2, and 6

As discussed below, the claimed technique *does* have patentably distinct elements not found in the references cited by the Examiner. For example, amended independent claim 1 recites, *inter alia*:

attaching an electrically conducting mounting stud to chassis;
attaching a ground clip adjacent a *mounting hole in the circuit board*;
extending a portion of the mounting stud *through the mounting hole*;
and
positively engaging the ground clip with *opposite sides of the portion* of the mounting stud.

First, as asserted in the previous Response, the Applicants reiterate that Klein et al. clearly fails to teach or suggest a mounting stud *extending through* the mounting hole in the circuit board, as recited in claim 1. In the Response to Arguments section of the Final Office Action, the Examiner asserted:

However, Claim 1 does not claim the mounting stud is *extending through* the board. On the other hand, Klein et al disclose positioning

the mounting stud through the mounting hole, since a screw, which is a component of the mounting stud and connected with a hole (22) of the stud through the mounting hole, will adjust position of the mounting stud (col. 5, lines 52-55).

Paper 10, page 5. Although the Applicants do not necessarily agree with the Examiner, the Applicants amended claim 1 to clarify the orientation of the mounting stud relative to the mounting hole in the circuit board. In view of this amendment, the Applicants emphasize that claim 1 clearly recites “*extending* a portion of the mounting stud *through* the mounting hole,” which is disposed *in* the circuit board. In contrast, Klein et al. teaches a mounting boss 10a engaged with a bracket 9a on only one side of a motherboard 2a, such that the mounting boss 10a *never extends through* the motherboard 2a. Col. 2, line 62 – Col. 3, line 1; Col. 4, lines 40-46; Col. 8, lines 35-37. Thus, the Klein et al. reference fails to teach or suggest the mounting stud *extending through* the mounting hole, as recited in claim 1.

Second, Klein et al. fails to teach or suggest “*positively engaging* the ground clip with opposite sides of the *portion* of the mounting stud,” as recited in claim 1. In the Office Action, the Examiner asserted that a *screw* is a component of the mounting stud that extends through the circuit board. See Paper 10, page 5. Again, although Applicants disagree with the Examiner’s assertion, the screw is incapable of being positively engaged by a ground clip, as recited in claim 1. Given that the screw is disposed inside the hole 22 of the mounting boss 10a, the bracket 9a cannot positively engage the screw. See Fig. 4; Col. 4, lines 37-46; Col. 5, lines 44-55. Moreover, the head of the screw is only accessible on the opposite side of the motherboard 2a relative to the mounting boss 10a and the bracket 9a. See *id.* Thus, the Klein et al. reference fails to teach or suggest a ground clip *positively engaging a portion* of the mounting stud *extended through* the circuit board, as recited in claim 1.

In view of the foregoing deficiencies of Klein et al., the Applicants respectfully request the Examiner withdraw the rejection of independent claim 1 and its dependent claims under 35 U.S.C. § 102.

Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 3-5 and 7-20 under 35 USC 103 as unpatentable over Klein et al in view of various secondary references. However, the Applicants believe these rejections are moot for the reasons discussed above with reference to claims 1, 2 and 6. The Applicants further stress that the cited references do not teach or suggest a ground clip adapted to spring open about a mounting stud *nose*, as recited by independent claim 7. Moreover, the cited references do not teach or suggest a ground clip adapted to spring open about an *upper nose* of a mounting stud, as recited by independent claim 13. In view of these deficiencies, the Applicants respectfully request the Examiner withdraw the rejection of claims 3-5 and 7-20 under 35 U.S.C. § 103.

Removal of Paquin Reference

In the previous Office Action, the Applicants requested that the Examiner remove Paquin (6,424,538) from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Paquin (6,424,538) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Compaq Information Technologies Group, L.P.

However, in the present Office Action, the Examiner responded to the Applicants' previous averment of common ownership, stating:

According to Applicants (p. 6 of the Amendment), Paquin (6,424,538) should be removed under p. 103c. However, it is necessary to confirm that the invention was made in a division of Compaq not in a division of Hewlett-Packard.

Paper 10, page 6.

Applicants remind the Examiner that common ownership is established without evidentiary support "if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time

the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s)." M.P.E.P. § 706.02(l)(3).

After an additional review of the assignment documents for Paquin and the present application, the Applicants wish to clarify the previous averment of common ownership. Accordingly, the Applicants respectfully stress that Paquin (6,424,538) should be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Paquin (6,424,538) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Compaq Information Technologies Group, L.P., *successor in interest to Compaq Computer Corporation*. Therefore, the Applicants respectfully request that the Examiner remove Paquin (6,424,538) from consideration. After Paquin (6,424,538) is removed according to 35 U.S.C. § 103(c), the Examiner's arguments regarding Paquin are moot.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: January 29, 2004



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